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Status of Claims

Claims 1-30 are pending in the application. Claims 1-30 have been rejected. Claims 1, 28-30 have been amended. No new matter has been introduced.

REMARKS

CLAIM REJECTIONS

Double Patenting Rejections

In the Office Action, the Examiner rejected claims 1-5, 7, 9-18, 20, 22-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of US Patent No. 6,689,392.

Applicant hereby offer to provide a terminal disclaimer upon indication by the Examiner of allowable claims.

35 U.S.C. § 112 Rejections

In the Office Action, the Examiner rejected claims 28-30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant maintains that claims 28-30 recite a first component and a second component in a claimed ratio, wherein the first component comprising one or more metal ion(s) and one or more chelating agent and the second component comprising the phosphorous acid, the salt or hydrate thereof, rendering the rejection moot. Accordingly, Applicant requests withdrawal of the rejection.

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1, 3-4, 11-15, 17 and 24-27 under 35 U.S.C. § 102(b), as allegedly being anticipated in view of WO 99/53760. Applicant disagrees.

Applicant thanks the Examiner for admitting that the composition of WO 99/53760 does not apply to living plants.

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The Examiner asserted that the phrase "plant diseases" can be broadly interpreted so as to encompass harvested plants, such as rotten tomatoes or fungal and bacterial infection of wood and therefore WO 99/53760 anticipates the present invention.

Applicant wishes to point out that to those familiar in the art of plant pathology would recognize the term "disease" to be applied only to living entities. According to Webster's Dictionary the term "disease" is defined as follows:

"A condition of the living animal or plant body or of one of its parts that impairs normal functioning and is typically manifested by distinguishing signs and symptoms."

Therefore, the phrase "plant diseases" could not be applied to dead plant matter or harvested fruit and which cannot develop any symptoms, e.g., logs and lumber.

Hence, the present invention is clearly not anticipated by the teachings of WO 99/53760.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1-5, 7-18 and 20-30 under 35 U.S.C. § 103(a), allegedly as being unpatentable over WO 00/62609 in view of Thizy et al. , U.S. Patent No. 4,075,324. Applicant disagrees.

The Examiner alleged that WO/00/62609 discloses a chelate of metal ions such as zinc and copper for the control of plant diseases. Thizy et al., teaches phosphorous acid and its salt for the control of plant diseases.

The Examiner admitted that the difference between the claimed invention and the cited references, is that the claimed invention discloses the combination of (a) one or more metal ions (elected zinc and copper) + (b) chelating agent and (c) phosphorous acid/salt/hydrate. The Examiner alleged that (a) + (b) is a known plant bactericide and fungicide as evidenced by WO/00/62609 and (c) is a known plant bactericide and fungicide as evidenced by Thizy et al. Therefore, to combine the two known bactericidal/fungicidal agents for the purpose of forming a third plant bactericidal/fungicidal agent, i.e., mixture of

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the two, would have been fairly suggested from the motivation to obtain the plant pathogen-controlling benefits of both plant bactericidal/fungicidal agents. Applicant disagrees.

According to the MPEP 2143.01:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so >. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

In addition, as the Federal Circuit has held numerous times that, a hindsight analysis such as that employed by the Examiner in the present case is impermissible -- instead, the Examiner must show suggestions, explicit or otherwise, that would compel one of ordinary skill to combine the cited references in order to make and use the claimed invention. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) ("When prior art references require selective combination by the [fact-finder] to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself."); *Fine*, 5 USPQ2d at 1600 ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."); *In re Pleuddemann*, 910 F.2d 823, 828 (Fed. Cir. 1990) (noting that use of an applicant's specification as though it were prior art to support an obviousness determination is legal error); *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) (holding that both the suggestion to combine references, and a reasonable expectation of success in making

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the claimed invention, "must be founded in the prior art, not in the applicant's disclosure.").

The Board has also provided the same mandate on this issue:

it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention may be rendered obvious a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

Ex parte Haymond, 41 USPQ2d 1217, 1220 (Bd. Pat. App. Int. 1996). Thus, the Examiner's hindsight analysis in the present case is impermissible and cannot be used to attempt to establish a *prima facie* case of obviousness.

Applicant demonstrated an unexpected synergistic effect by combining the components in the claimed ratios, controlling plant diseases caused by pathogenic microorganisms, greater than either component alone. This effect was clearly surprising and unexpected at the time the invention was made.

For example Tables 1-4 indicate using tomato and potato plants at different ratios between the metal chelate (AG) and the phosphorous salt (K_3PO_3), or phosphorous acid (H_3PO_3) of 1:1, 2:1 and 3:1, respectively obtaining efficiency more than either alone. Neither WO 00/62609 or Thizy describe such effective inhibition of fungus when administered to a plant, nor would one expect their combination to provide these results, over the various ratios exemplified.

Accordingly, Applicant requests withdrawal of the rejection.

Similarly, the Examiner rejected claims 1, 3-6, 9-15, 17-19 and 22-30 under 35 U.S.C. § 103(a), allegedly as being unpatentable over Taylor (U.S. Pat. No. 6,139,879) and Thizy et al. (U.S. Pat. No. 4,075,324). The Examiner asserted that Taylor et al discloses non-phytotoxic heavy metal chelates for the control of plant diseases. Thizy et al., teaches

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phosphorous acid and its salt for the control of plant diseases. The Examiner's rejections are respectfully traversed.

As above, there is no motivation to combine the teachings of the cited references by combining the components in the claimed ratios. As the Federal Circuit instructed, motivation to combine must be taught or at least suggested in the references themselves.

Applicant submits that based on the same arguments presented hereinabove it could not have been obvious to an ordinary person skilled in the art, at the time the invention was made, to combine the teachings of Taylor and Thizy et al. so as to obtain a composition which has a synergistic effect on controlling plant diseases caused by pathogenic microorganisms. Accordingly, Applicant requests withdrawal of the rejection.

Applicant notes that none of the amendments to the claims herein are in response to the above discussed prior art rejections.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.


Respectfully submitted,

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